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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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12/18/2001

Kazuki Matsui

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8732

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STAAS & HALSEY LLP

SUITE 700

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EXAMINER

BEKERMANN, MICHAEL

ART UNIT

PAPER NUMBER

3622

MAIL DATE

DELIVERY MODE

03/21/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/020,248	<b>Applicant(s)</b> MATSUI ET AL.	
	<b>Examiner</b> MICHAEL BEKERMAN	<b>Art Unit</b> 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,4-6,8-17,20 and 21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4-6,8-17,20 and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

This action is responsive to papers filed on 5/29/2007.

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/20/2007 has been entered.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1, 4-6, 8-17, 20, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bernstein (U.S. Pub No. 2002/0107730) in view of Herz (U.S. Patent No. 5,754,938).**

Regarding claims 1, 10, 11, 14-17, and 20, Bernstein teaches storing product information including product name and attribute for many different products (or product

groups) (Paragraph 0017), accepting selection of a product from a merchant by a consumer (Paragraph 0025), assigning a correspondence between a consumer identifier and the product (transaction) (Paragraph 0023), and providing to the consumer a recommendation of a different product from a different merchant based on the first selected product (Paragraphs 0014, 0016, and 0023). Bernstein also teaches the system and method as being implemented at a physical vendor as well as through the Internet (Paragraph 0013). To link similar products to each other, product attributes must inherently be stored in the system. Bernstein teaches the system as comprising any number of vendors and any number of customers (and thus, inherently more than 2 products) (Paragraph 0010). For a customer purchase history to be present, there must be a quantity purchased of at least 1 stored.

Bernstein teaches the user's identity as being kept private from merchants on the system by using a customer information summary (Paragraph 0019) and a customer identifier (Paragraph 0023). Bernstein also teaches that buyers have a right to privacy (Paragraph 0005). Bernstein doesn't appear to specify the identifier as varying for each merchant. Herz teaches the ability of a user to vary his information per merchant (Abstract). It would have been obvious to one having ordinary skill in the art at the time the invention was made to create a different identifier for each merchant in the interest of enhancing consumer privacy even further between specific merchants. Herz does not appear to specify the modification of an existing identifier to determine a new identifier for an alternate merchant. Herz teaches the old and well-known method of encryption for keeping certain information more secure (Figure 14, Reference 1401).

Webster's dictionary defines the act of encrypting as "to put into code or cipher", which is simply a method of encoding, or modifying, information. While Herz does not specify using encryption to alter an identifier to create a new identifier, one of ordinary skill would have recognized that applying the known technique of encryption would have yielded predictable results and resulted in an improved (and more secure) system.

**Regarding claim 4**, Bernstein teaches authenticating the redeemed promotional materials (Paragraph 0022). Once this authentication takes place, the purchase will be added to the purchase history of the consumer and this reads on storing a correspondence between the user identifier and the second product.

**Regarding claim 5**, Bernstein teaches redemption of the promotional materials (Paragraph 0022). This inherently reads on a payment process.

**Regarding claims 6 and 8**, Bernstein teaches the system as comprising any number of vendors and any number of customers (and thus, inherently more than 2 products) (Paragraph 0010). Thus, the referral system of Bernstein would similarly continue as in claims 1-3 for a third merchant. Thus, these claims would be rejected under the same basis as those claims.

**Regarding claim 9**, Bernstein doesn't specify the ability for a merchant to update product information. Since Bernstein teaches the product information as being available on the system, it would have been obvious to one having ordinary skill in the art at the time the invention was made to allow merchants the ability to alter that information at a later date in case the product information changes.

**Regarding claims 12**, Bernstein teaches providing purchase history to a participating (second) vendor (Paragraph 0018).

**Regarding claim 13**, Bernstein teaches providing consumer information only in summary form (Paragraph 0019). This represents a disclosure level.

Regarding claim

**Regarding claim 21**, neither Bernstein nor Herz appear to specify deleting an identifier should a recommended product not be selected after a given period of time. Official Notice is taken that it is old and well-known to delete an account of a user after a fixed period of inactivity. Hotmail is an example of an website email service that deletes a user's email account if it goes unused over a specified period of time. It would have been obvious to one having ordinary skill in the art at the time the invention was made to delete an identifier for a user should that identifier go unused in the interest of keeping records more organized.

### ***Response to Arguments***

Applicant's arguments directed towards the "modifying" feature in the independent claims have been addressed in the rejections above. All newly added language has been underlined for Applicant's convenience.

### ***Conclusion***

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL BEKERMAN whose telephone number is

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(571)272-3256. The examiner can normally be reached on Monday - Friday, 7:30 - 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Eric W. Stamber/  
Supervisory Patent Examiner, Art Unit 3622